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10/786,707  
67097-023; 11106UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ellington et al.

Serial No.: 10/786,707

Filed: 02/25/2004

Art Unit: 1723

Examiner: Fortuna, Ana M.

Title: **METHOD FOR PRODUCING A NON-POROUS  
MEMBRANE**M/S Appeals and Interferences  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450REPLY BRIEF

Dear Sir:

The following remarks are in reply to the Examiner's Answer dated 28 April 2008. The Appeal Brief fee has already been paid. If additional fees are necessary, you are hereby authorized to charge Deposit Account No. 21-0279 in the name of United Technologies Corporation.

REMARKS

Respectfully, the Examiner's Answer raises numerous additional issues that require a brief response as follows.

Regarding Appellant's arguments under Section I of the Appeal Brief, the Examiner commented that the test for anticipation is not what the reference "teaches." The MPEP explicitly states that to anticipate a claim, a reference must teach every element of the claim. See MPEP 2131. In this regard, the Examiner must find each and every claim element expressly or

10/786,707  
67097-023; 11106

inherently described in a single prior art reference. However, the cited reference does not disclose the claimed "indistinct, seamless boundary." The Examiner appears to provide this missing limitation through speculation and opinion, without any supporting evidence other than the statements of the Examiner. Respectfully, the Examiner's unsupported statements and opinions do not constitute an identical description of the claimed invention as required to establish anticipation.

Additionally, the Examiner seems to acknowledge that there would be some demarcation, seam, or difference between the two membrane layers of the cited reference. The Examiner commented that there would be no distinction between the layers "other than the pore size" (see page 3 of the Examiner's Answer). Therefore, the Examiner appears to admit that there would be some type of seam between the layers of the cited reference, contrary to the claim requirement of an "indistinct, seamless boundary."

Regarding Applicant's argument under Section III of the Appeal Brief, the Examiner commented that the Applicant has failed to respond to the question of how an indistinct, seamless boundary can be produced between layers in the claims. Appellant notes that the burden is on the Examiner under an obviousness inquiry to establish that the cited references disclose or teach all of the claimed elements and that there is a reason to combine the elements in the manner claimed. In this regard, the Examiner relies on either the Bowser reference or the Nemser reference to establish obviousness (i.e., the rejection is in view of Bowser or Nemser). Thus, the Examiner cannot rely on one reference for some of the claimed features and the other reference for other claimed features as the Examiner appears to be doing by stating that "reliance for that teaching was on another 'reference' [Bowser]." Therefore, the Examiner seems to be admitting that the rejection based on the Nemser reference should be withdrawn, because Nemser does not teach drying between forming multiple layers. Moreover, to the extent that the Examiner relies on the Bowser reference for teaching drying between coating stages, the Examiner is again speculating that the resultant membrane layers that would be produced using the disclosure of Bowser would have the claimed indistinct, seamless boundary.

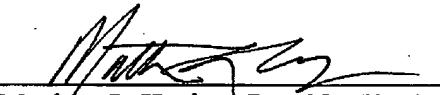
JUN 26 2008

10/786,707  
67097-023; 11106

CLOSING

For all of the reasons set forth above, and the reasons set forth in Appellant's Appeal Brief, the rejection of the claims is improper and should be reversed.

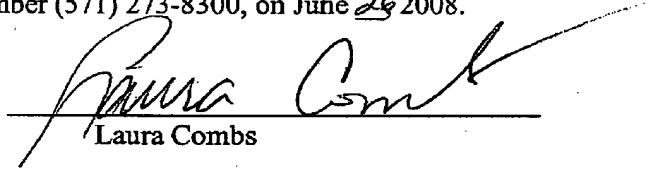
Respectfully submitted,

  
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Dated: June 26, 2008

CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, fax number (571) 273-8300, on June 26 2008.

  
Laura Combs